

REMARKS

This application has been reviewed in light of the Office Action dated August 4, 2005. Claims 1-4, 6-9, 11-17, 20-23 remain in this application, with Claims 1, 17 and 23 being in independent form. Claims 5, 10, 18 and 19 have been canceled. Claim 1 has been amended to define still more clearly what Applicant regards as his invention, in terms that distinguish over the art of record. Claim 23 has been added to provide Applicant with a more complete scope of protection. Favorable reconsideration is respectfully requested.

The Office Action objected to Claims 12-15 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form. New independent Claim 23 includes the subject matter of Claims 1, 11 and allowable subject matter of Claim 12, thereby making Claim 23 allowable.

The Office Action rejected Claims 1-4, 6 and 9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,714,035 (Stevens); rejected Claims 1-4, 17, 18, 21 and 22 under 35 U.S.C. § 102(a) as being anticipated by Japanese Patent Application No. 2001-089011 (Katsuaki); rejected Claims 1, 2, 4-6 and 9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,303,759 (Czech); rejected Claims 1-4, 9, 11, 16, 17 and 20-22 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Application No. 10-181289 (Fujii); and rejected Claims 1-4 and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,714,035 (Stevens). Applicant respectfully traverses these rejections.

Applicant submits that independent Claims 1 and 17, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art at least for the following reasons.

Initially, with regard to Claim 1, Applicant submits that nothing has been found in the cited prior art that would teach or suggest a hand-held device for transferring a film onto a substrate that includes, among other things, a device where at least one of the motion stops are formed by lateral webs guiding the film.

In addition, Applicant requests that the Examiner consider the following comments related to the prior art cited in the Office Action.

Stevens shows in Fig. 1 a design that includes an end portion of a support member 9 inserted into a slot 18 and open to the rear end of the application tip 10. The tip 10 is also

provided with guide wings 16. However, these guide wings 16 do not contribute to any limitation of a relative movement between the support member 9 and the tip member 10.

Claim 17 requires that an application member include at least two application member portions moveable relative to each other, wherein each of the moveable application member portions are formed by flat gips and lateral (guiding) webs that protrude from both sides of the flat gips. Therefore, both moveable member portions are provided with lateral guide webs.

Stevens shows guide wings 16 that are only provided at the tip portion 10. The support member 9, on the other hand, is void of such guide wings or guide webs. At least for this reason, Applicant submits that Claim 17 is patentable over Stevens.

In regard to Katsuaki, the Office Action states that Katsuaki anticipates Claim 17. However, Applicant was not able to find any detailed statement in this regard in the Office Action. Nonetheless, Applicant submits that Fig. 4 of Katsuaki shows a tip member that includes, among other things, a main beam element 8 and a pressing portion 9. Moreover in Katsuaki, the guide wings 12 protrude rearward from the application edge element 9'.

Applicant submits that there is no teaching or suggestion in Katsuaki that the main beam element 8 of the application member and the guide wings actually represent motion stops. The beam element 8 has been assigned to allow a torsional movement of the beam element, in which case the guide wings could not constitute any type of motion stops. The guide wings are provided at the side of the beam element so that in case there is a torsional movement of the beam element these guide wings would simply rotate around the beam element.

When looking at figures 3 and 4 of Katsuaki, it can clearly be seen that when using a device as proposed by Katsuaki, only a torsional movement or a flexing movement can occur when pressing the correction tape device against a substrate. In both cases, the guide webs will not be against the main beam element 8 of the application member.

Therefore, not only is Katsuaki silent about the motion stops, when handling the device as shown in the figures of Katsuaki they can never satisfy the function of a motion stop as the guide wings 12 are placed at both sides of the element 8. At least for these reasons, Applicant submits that Claim 17 is patentable over Katsuaki.

Fujii shows a correction device with an application member, which is potentially moveable with regard to the main casing of the device. However, in contrast to the present invention as recited, e.g., in Claim 17, the application member according to Fujii is not

provided with two moveable parts respectively provided with the motion stops. Any limitation of the movement of the application member according to Fujii is limited by the application member abutting against the casing of the correction device. Therefore, at least for this reason, Applicant submits that Claim 17 is patentable over Fujii.

Czech fails to teach the provision of motion stops, wherein at least one motion stop is formed by a lateral tape guiding web. In particular, in Fig. 9b of Czech, Czech is comparable to Stevens insofar as the relative motion and any motion limitation is taking place in the interior of the application member and not at the outside thereof.

As both Stevens and Czech rely on such a "ball bearing," it is simply impossible to form at least one of the motion stops as a guide web for the tape as the tape is, of course, arranged at the outer surface of the application member and not at the interior thereof.

Also, in the design according to Stevens, it would be impossible to form a motion stop as a guide web as the relative motion is taking place in the slot area 10 and thus in the interior of the application member.

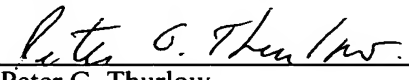
The other rejected claims in this application depend from either Claim 1 or Claim 17 discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at the phone number listed below. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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